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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,968	01/28/2002	Diana L. Kosinski	103864.129US1	8431
24395	7590	07/12/2004	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP THE WILLARD OFFICE BUILDING 1455 PENNSYLVANIA AVE, NW WASHINGTON, DC 20004			BLECK, CAROLYN M	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/055,968

Applicant(s)

KOSINSKI ET AL.

Examiner

Carolyn M Bleck

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 2 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): 112, 1<sup>st</sup> & 112, 2<sup>nd</sup> rejections
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

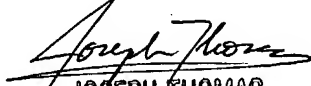
Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-69.

Claim(s) withdrawn from consideration: None.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
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Continuation of 2. Note: The addition of claims 70-74 would require further search and consideration.

Continuation of 5. does not place the application in condition for allowance because:

(A) The new matter rejection under 35 USC 112 is hereby withdrawn due to the response filed 2 June 2004.

(B) The objection to claim 46 are hereby withdrawn due to the response filed 2 June 2004.

(C) The rejection of claim 18 under 35 USC 112-2 is hereby withdrawn due to the response filed 2 June 2004.

(D) The rejection of claim 65 and 67-69 under 35 USC 112-1 is hereby withdrawn due to the response filed 2 June 2004.

(E) At pages 32-34 of the 2 June 2004 response, Applicant argues that the applied prior art fails to teach the step of "independently assessing by personnel associated with the prescription processing system correctness of the prescription request."

In response, the Examiner respectfully submits that the Applicant is attacking the references individually. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, the Examiner respectfully submits that the proper viewing of the applied references is as follows: the collective teachings of Albaum and Walker fail to expressly disclose "independently assessing by personnel associated with the prescription processing system correctness of the prescription request". However, such a feature is suggested by Albaum by the disclosure of requiring a physician to countersign orders electronically and upon sending a prescription refill, having the authorization for the prescription verified (col. 15 lines 33-49, col. 18 lines 1-6). It is noted that typically "countersigning" an order for a prescription would include the physician viewing the order to determine whether or not it is a proper order before the physician signs the order.

Simcox discloses a system where a prescriber transmits a prescription to a computer either within the prescribers office or at the point of pharmaceutical distribution (col. 4 lines 21-40 and col. 5 lines 1-25). Further Simcox discloses upon a pharmacist receiving the completed prescription, the pharmacist interpreting the pharmaceutical identification and confirming this interpretation by correlating the specific pharmaceutical identified in the pharmaceutical identification section with the application being identified in a graphical indicia section, and then in the event that the pharmaceutical identified does not serve the purpose illustrated by the selected graphical icon, the pharmacist immediately knows that the pharmaceutical is incorrect, wherein the graphical icons are classes of pharmaceuticals such as Cough/Cold, respiratory/lung disorders, etc.) (col. 3 line 65 to col. 4 line 8, col. 4 lines 21-40 and col. 5 lines 1-25).

The motivation for combining Simcox within the method taught collectively by Albaum and Walker is to prevent a pharmaceutical from being dispensed that is incorrect, thus preventing a potentially dangerous situation for a patient (Simcox; col. 4 lines 21-40).

In addition, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a non-physician user to electronically sign a patient's orders" (see page 33 of the 2 June 2004 response) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(F) Applicant's remaining arguments with regards to the feature of "independently assessing..." in claims 37, 38, 39, 40, 56-58, 59, 60, 64-65, 67, and 68-69 of the response filed 2 June 2004 rely upon or rehash the issues addressed above, and are therefore moot in view of the responses given in section E above, and incorporated herein.

(G) At pages 34-35 of the 2 June 2004 response, Applicant argues that the applied prior art fails to teach the features of claim 9.

In response, the Examiner respectfully submits that Albaum discloses performing an order recognition function by an order reformatter and interpreter to check for recognition of the doses, route of administration, frequency, and duration, wherein the order information received by the order reformatter and interpreter when entered by the user is entered in random sequence and then processed, wherein the inpatient module (reads on

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"prescription processing system") performs processing functions and is connected to a user interface which accepts input via keyboard and mouse, voice recognition, or pen interface (reads on "capturing..." and "converting...") (Fig. 49e and 49f, col. 7 lines 25-30, col. 11 lines 4-13, col. 20 line 40 to col. 21 line 33). Further, Albaum discloses the inpatient module performing all of the primary processing function represented by the order reformatter and interpreter, including voice recognition, which would include converting voice to digital data (col. 7 lines 25-30).

It is the position of the Examiner that claim 9 is disclosed by the prior art.

(H) At page 35 of the 2 June 2004 response, Applicant argues that the applied prior art fails to teach the features of claim 27 by attacking the references individually.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(I) At page 36 of the 2 June 2004 response, Applicant argues that the applied prior art fails to teach the features of claim 55.

In response, the Examiner respectfully submits that the features of claim 55 are taught by the applied prior art. See Albaum: the inpatient module performs processing functions and is connected to a user interface which accepts input via keyboard and mouse, voice recognition, or pen interface (Fig. 49e and 49f, col. 7 lines 25-30, col. 11 lines 4-13, col. 20 line 40 to col. 21 line 33). Further, Albaum discloses the inpatient module performing all of the primary processing function represented by the order reformatter and interpreter, including voice recognition, which would include converting voice to digital data (col. 7 lines 25-30).

(J) At pages 43-45 of the 2 June 2004 response, Applicant argues that the applied prior art fails to teach the features of claims 18-23.

In response, the Examiner respectfully submits that the features of claims 18-23 are taught by the applied prior art.

As per claim 18 Albaum and Walker fail to disclose determining if there is an existing "unique" prescription number for renewal and requesting the existing prescription number if it is available. Rhodes discloses determining if the prescription number entered by the user is a valid prescription number (i.e., "0000004") by comparing the prescription number against those stored in the data storage device, and if the prescription number is valid, displaying basic information relating to the prescription number, wherein the user enters the prescription number through a Refill RX screen, and wherein the system automatically finds the patient associated with the prescription number needing a refill (Fig. 26, 45-47, col. 17 line 18 to col. 18 line 47, col. 28 line 15 to col. 29 line 20, col. 30 lines 45-58). It is noted that the "prescription number" of Rhodes is "unique" because the Rhodes system retrieves a single patient associated with the single prescription number. At the time the invention was made, it would have been obvious to include the features of Rhodes within the method taught collectively by Albaum and Walker with the motivation of reducing the amount of time from when an order for a prescription is written to when it is received in the pharmacy (Albaum; col. 1 lines 30-36).

As per claims 19-21, Albaum discloses a database containing health and medication information regarding medications and a patient, and a means for alerting the user to potentially adverse situations as a result of the prescribed medications, based on information in the database, wherein the adverse situation is an allergic reaction to the prescribed medication, wherein the adverse reaction is an interaction between two or more prescribed medications (col. 13 lines 44-65, col. 18 lines 1-6, col. 21 lines 34-45, col. 22 lines 29-50). Further, Albaum discloses the database storing ongoing lab data with respect to a patient, wherein a message is displayed to the user to recommend drug changes based on ongoing lab data, wherein a means for permitting the user to modify the prescribed medications based on the information, such as the lab data displayed to user, wherein modification includes entering accepting at least one medication identifier (col. 13 lines 44-65, col. 18 lines 1-68, col. 20 lines 40-68, col. 21 lines 34-45, col. 22 lines 29-50). Albaum includes countersigning the prescription order electronically by a physician, processing the order immediately, and then closing the ordering screen (col. 13 lines 44-65, col. 18 lines 1-6, col. 21 lines 34-45, col. 22 lines 29-50). Also, Albaum includes screen selections available to the physician for requesting special treatment authorization for non-formulary drugs, and if the user does not authorize the drugs, the order is cancelled (col. 16 lines 20-47, col. 18 lines 1-6, col. 20 lines 10-15).

As per claims 22-23, Albaum discloses entering into a user interface a patient identifier for a patient, wherein the identifier includes the patient's name, patient's location, or ID number, wherein patient demographic data such as name, address, telephone number, date of birth, sex, diagnosis, allergies, height, weight, medical folder/record number, and insurance plan are collected through a patient information database (Fig. 2-9, col. 15 lines 49-55 and col. 21 lines 1-15) and accepting and processing information regarding medication prescriptions for a patient, wherein the information includes a medication identifier, medication dosage, medication frequency, medication duration, medication quantity, maximum dosage recommended for a patient (col. 20 lines 41-68).

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In addition, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

(K) At page 45 of the 2 June 2004 response, Applicant argues that the applied prior art fails to teach the features of claims 28 and 66.

In response, Furthermore, the Examiner respectfully notes that neither of the Albaum, Walker, Simcox, and Bartur references were ever applied as references under 35 U.S.C. 102 against the pending claims. As such, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches the claimed features, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of these features. Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lulu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In this case, each limitation recited in claims 28 and 66 has been addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Albaum, Walker, Simcox, and Bartur based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as clearly detailed in the remarks and explanations given above, and incorporated herein.

In addition, Albaum and Walker fail to expressly disclose these newly added limitations. However, Albaum suggests the step of verifying who a user's identity by disclosing an inpatient module performing all of the primary processing function represented by the order reformatter and interpreter (col. 7 lines 25-30) and requiring a physician to countersign orders electronically and upon sending a prescription refill, having the authorization for the prescription verified (col. 15 lines 33-49, col. 18 lines 1-6). Bartur discloses verifying by a database a patient ID, physician ID, and medication ID by matching the patient ID, physician ID, and medication ID with stored IDs in the database, wherein if the IDs are verified, the prescription is dispensed by a medication unit dispensing stored medications (Abstract; col. 11 lines 30-50, col. 13 line 49 to col. 14 line 44). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Bartur within the method taught collectively by Albaum, Walker, and Simcox with the motivation of preventing a pharmaceutical from being dispensed that is incorrect, thus preventing a potentially dangerous situation for a patient (Simcox; col. 4 lines 21-40). As per the recitation of a "physician's phone number", it is noted that Bartur's Physician ID may include a physician's phone number as the ID. It would have been obvious within the method taught collectively by Albaum, Walker, Simcox, and Bartur to include using a phone number with the motivation of providing a physician with an identifier that is easy to remember.

(L) At page 46 of the 2 June 2004 response, Applicant argues that there is not motivation to combine the applied prior art within claims 29, 54, and 63.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In

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this case, the motivation is based on the teachings of the applied prior art ("allowing a user to quickly interact with a prescription system by the system automatically answering the telephone call and beginning to interact with the user (Munoz; par. 4)") and in the knowledge generally available to one of ordinary skill in the art ("providing a system for users who may not have a computer to input information, thus increasing the number of users of the system).

(M) At page 46 of the 2 June 2004 response, Applicant argues that the applied prior art fails to teach the features of claim 46.

In response,

(N) At pages 63-64 of the 2 June 2004 response, Applicant argues that there is not motivation to combine the applied prior art within claims 61-62.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is based on the teachings of the applied prior art ("allowing a user to quickly interact with a prescription system by the system automatically answering the telephone call and beginning to interact with the user (Munoz; par. 4)") and in the knowledge generally available to one of ordinary skill in the art ("providing a system for users who may not have a computer to input information, thus increasing the number of users of the system).

(O) Applicant's remaining arguments of the response filed 12 June 2003 rely upon or rehash the issues addressed above, and are therefore moot in view of the responses given in sections (A)-(N) above, and incorporated herein.